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**MAILED**

**MAR 16 2012**

**OFFICE OF PETITIONS**

In re Application of :  
Casebolt et al. :  
Application No. 09/370,121 :  
Patent No. 6,490,153 : DECISION ON PETITION  
Filed: August 6, 1999 : PURSUANT TO 37 C.F.R.  
Issue Date: December 3, 2002 : § 1.378(B)  
Attorney Docket No. M-7792-US :  
Title: COMPUTER SYSTEM FOR :  
HIGHLY-DENSE MOUNTING OF SYSTEM :  
COMPONENTS :

This is a decision on the petition filed on February 16, 2012, pursuant to 37 C.F.R. § 1.378(b) to reinstate the above-identified patent.

This petition pursuant to 37 C.F.R. § 1.378(b) is **DISMISSED**.

**Background**

The patent issued on December 3, 2002. The grace period for paying the 3½-year maintenance fee provided in 37 C.F.R. § 1.362(e) expired at midnight on December 3, 2006, with no payment received. Accordingly, the patent expired on December 3, 2006 at midnight.

Any petition to accept an unavoidably delayed payment of a maintenance fee filed under 37 C.F.R. § 1.378(b) must include:

- (1) the required maintenance fee set forth in 37 C.F.R. § 1.20(e) through (g);
- (2) the surcharge set forth in 37 C.F.R. § 1.20(i)(1), and;
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be

paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent - the showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The surcharge associated with a petition to accept the late payment of a maintenance fee as unavoidable was submitted on February 16, 2012, along with a statement of facts. Petitioner has further included a portion of the required maintenance fees.

The second requirement of Rule 1.378(b) has been satisfied. The first and third requirement of Rule 1.378(b) have not been satisfied, as will be discussed below.

### **The standard**

35 U.S.C. § 41(c)(1) states, *in pertinent part*:

The Director may accept the payment of any maintenance fee... after the six-month grace period if the delay<sup>1</sup> is shown to the satisfaction of the Director to have been unavoidable.

37 C.F.R. § 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 37 C.F.R. § 1.137(a). This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business.<sup>2</sup>

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Nonetheless, a

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<sup>1</sup> This delay includes the entire period between the due date for the fee and the filing of a grantable petition pursuant to 37 C.F.R. § 1.378(b).

<sup>2</sup> In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (*quoting Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."<sup>3</sup>

The burden of showing the cause of the delay is on the person seeking to revive the application.<sup>4</sup>

**Application of the standard to the current facts and circumstances**

Regarding the first requirement of 37 C.F.R. § 1.378(b), the other-than small entity fees that are currently associated with the 3½ and the 7½-year maintenance fees are \$1,130 and \$2,850, respectively. Petitioner appears to be under the mistaken impression these fees are \$980 and \$2480, respectively.<sup>5</sup> Consequently, these fees were submitted instead of the proper amount. It follows these fees have not been submitted in full, and an additional \$520 is required to make up the deficiency.

Regarding the third requirement of 37 C.F.R. § 1.378(b), Petitioner has explained that on or about August 1, 2011, he learned this patent has expired for failure to submit the 3½ year maintenance fee,<sup>6</sup> and has alleged the Assignee

engaged the law firm of Skjerven Morill MacPherson LLP to pay the first maintenance fee on April 5, 2007. Further, Applicant engaged the law firm of Skjerven Morrill MacPherson LLP to pay the maintenance fees.

Arun statement of facts, paragraph 2.

Petitioner explains that on an unspecified date, he "realized that the law firm of Skjerven Morill MacPherson LLP had gone out of business and was defunct."<sup>7</sup>

The period for paying the 3½-year maintenance fee without the surcharge extended from December 3, 2005 to June 3, 2006 and for paying with the surcharge from June 4, 2006 to December 3, 2006. Thus, the delay in paying the 3½-year maintenance fee extended from December 3, 2006 at midnight to the filing of this petition on February 16, 2012.

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<sup>3</sup> Haines v. Quigg, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

<sup>4</sup> Id.

<sup>5</sup> Petition, page 2.

<sup>6</sup> Arun statement of facts, paragraph 3.

<sup>7</sup> Id. at 5.

Patentee has provided an indication of the date on which he became aware of the expiration of the patent.

The record does not contain a showing that the delay was unavoidable, as will now be pointed out.

First, the record does not contain an enumeration of the steps taken to ensure timely payment of the maintenance fee. An adequate showing that the delay in payment of the maintenance fees at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Where the record fails to disclose that the patentee took reasonable steps to ensure timely payment of the maintenance fees, 35 U.S.C. § 41(c) and 37 C.F.R. § 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR § 1.378(b)...

Petitioner has indicated "Assignee engaged the law firm of Skjerven Morill MacPherson LLP to pay the first maintenance fee on April 5, 2007." However, as set forth above, the patent expired on December 3, 2006 at midnight. As such, the Assignee engaged a law firm to pay the first maintenance fee *more than four months after the patent had expired for failure to timely submit the same*. It follows the record does not support a finding that any steps were in place to ensure the timely payment of the first maintenance fee.

Moreover, Petitioner will note that a patent holder's reliance upon an attorney does not provide him with an absolute defense, but rather shifts the focus to whether the attorney acted reasonably and prudently.<sup>8</sup> It is well established that a patent holder is bound by any errors that may have been committed by his attorney.<sup>9</sup> Petitioner will need to establish that any alleged failure of the law firm of Skjerven Morill MacPherson LLP could not have been avoided with the exercise of due care. Whether an action by an attorney constituted a breach of the fiduciary duty of care is of no moment to the issue of whether the entire delay was unavoidable.<sup>10</sup>

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<sup>8</sup> California Medical Products v. Technol Med. Prod., 921 F. Supp. 1219, 1259 (D. Del. 1995).

<sup>9</sup> Smith v. Diamond, 209 U.S.P.Q. 1091, 1093 (D.D.C. 1981) (citing Link v. Wabash Railroad Co., 370 U.S. 626, 8 L. Ed. 2d 734 (1962)).

<sup>10</sup> See Haines v. Quigg, 5 USPQ2d 1130 (N.D. Ind. 1987) (the court, in affirming an Office decision denying revival of an application on the basis of unavoidable delay, stated: "If the attorney somehow breached his duty of

Second, the record does not contain a description of the manner in which patentee became aware of the expiration of the patent.

Third, the record does not contain a description of the steps taken to file the petition promptly. Petitioner has indicated he learned of the expiration of this patent on August 1, 2011. Why was this petition not filed until more than six months had passed?

### Conclusion

Any request for reconsideration of this decision must be filed within **TWO MONTHS** of the mailing date of this decision. Any such petition for reconsideration must be accompanied by the \$400 petition fee set forth in 37 C.F.R. § 1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Accordingly, on request for reconsideration, it is extremely important that Petitioner supply any and all relevant information and documentation in order to meet his burden of showing unavoidable delay. This includes statements by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Petitioner must provide documentation and address the deficiencies noted above. If on request for reconsideration, the delayed payment of the maintenance fees is not accepted, then the maintenance fees are subject to refund following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed.

The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.378(e)". This is not a final agency action within the meaning of 5 U.S.C § 704.

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail,<sup>11</sup> hand-delivery,<sup>12</sup> or facsimile.<sup>13</sup>

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care to plaintiff, then plaintiff may have certain other remedies available to him against his attorney. He cannot, however, ask the court to overlook [attorney's] action or inaction with regard to the patent application.")

11 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

12 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

13 (571) 273-8300: please note this is a central facsimile number.

Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.<sup>14</sup>

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225. Inquiries pertaining to the submission of maintenance fees should be directed to the Maintenance Fee branch at 571-272-6500.



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Paul Shanoski  
Senior Attorney  
Office of Petitions

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<sup>14</sup> <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>